REMARKS

Status of the Application

Claims 1-34 are pending in this application. All claims have been rejected.

Claim Rejections Under 35 USC §102 Over Wu

The Examiner rejects all claims on one basis, as explained in the Office Action:

> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
>
> A person shall be entitled to a patent unless -
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> 1. Claims 1-34 are rejected under 35 U.S.C. 102(a) as being anticipated by Wu (Three-Dimensional Mammography Reconstruction Using Low-Dose Projection Images).

Applicants respectfully disagree, as the Wu reference is not prior art.

Correctly, the Examiner bases the rejection on 35 U.S.C. §102(a) as the document details included with the Wu reference state on their face that the date of the reference is September 2002 – less than one year before Applicant's February 2003 priority date. However:

> [O]ne's own work is not prior art under §102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under §102(a). Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed (or subject matter obvious therefrom) only when the disclosure occurred more than one year prior to the date of the application, that is when the disclosure creates a one-year time bar, frequently termed a "statutory bar," to the application under §102(b). In re Katz, 687 F.2d 450, 454, 215 USPQ 14 (CCPA 1982).

The Wu reference consists of the doctoral thesis of Tao Wu, the first named inventor on this application. In addition, the Wu reference expressly acknowledges the contribution of all of the co-inventors (Alex Stewart, Martin Stanton, Walter Phillips, Daniel B. Kopans, and Richard Moore) to its publication on the "Acknowledgements" page numbered (iv) in the thesis.

> Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by application himself/herself or on his/her behalf . . . Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 C.F.R. 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 C.F.R. 1.132 establishing that the article is describing applicant's own work. MPEP 715.01(c).

The attached Declaration of Tao Wu demonstrates that the co-inventors on the patent application also contributed to the Wu reference – that is, the reference is not the publication of another, but it is a publication by the same inventive entity named on the patent application – the Wu reference is the inventors' own work and cannot be prior art under 35 U.S.C. §102(a).

Because the Wu thesis is not prior art, the claims cannot be rejected over it and the rejection is overcome.

Finality of the Rejection

In making the rejection final, the Examiner asserts:

> Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a).

Applicants disagree.

The Wu thesis was declared and cited in an IDS submitted December 22, 2005. In fact, the Examiner initialed the entry on the IDS for the Wu thesis and returned the initialed form with the Office action mailed on March 17, 2006. Applicants' most recent amendment merely moved "tomosynthesis" from the preamble into the body of the claims (and made other amendments only for section 101 reasons). If the Wu thesis anticipated the Wu application after this amendment, it no doubt anticipated before. MPEP 706.07(a), cited by the Examiner, states:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims ***nor based on information submitted in an information disclosure statement*** . . . [Emphasis added.]

In the present case, the reference that forms the basis of the new rejection was properly cited on an IDS and initialed by the Examiner – the Office action cannot be made final. In addition, the new grounds were not necessitated by the substantive amendment, which added no new language to the claims.

Applicants expressly request that the "final" designation be removed.

CONCLUSION

In light of the fact that the finality of this rejection is incorrect, Applicants expressly request that the Examiner grant a telephonic interview if it is determined that this application will not issue to Allowance. Applicants have filed an Interview Request Form herewith.

In the event that a petition for an extension of time is required to be submitted at this time, Applicant hereby petitions under 37 CFR 1.136(a) for an extension of time for as many months as are required to ensure that the above-identified application does not become abandoned.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 141449, under Order No. 102282-15.

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Respectfully submitted,

By _____

Ronald E. Cahill
Registration No.: 38,403
NUTTER MCCLENNEN & FISH LLP
World Trade Center West
155 Seaport Boulevard
Boston, Massachusetts 02210-2604
(617) 439-2782
(617) 310-9782 (Fax)
Attorney for Applicant

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